

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q76502	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/629,597	July 30, 2003	
	First Named Inventor		
	Beatrice MARTIN		
	Art Unit	Examiner	
	2144	Mohamed IBRAHIM	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s).</p> <p style="padding-left: 40px;">Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>59,043</u></p> <p style="text-align: right;"><u>/Mark E. Wallerson/</u> Signature</p> <p style="text-align: right;"><u>Mark E. Wallerson</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 293-7060</u> Telephone number</p> <p style="text-align: right;"><u>April 28, 2008</u> Date</p>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76502

Beatrice MARTIN, et al.

Appln. No.: 10/629,597

Group Art Unit: 2144

Confirmation No.: 6211

Examiner: Mohamed IBRAHIM

Filed: July 30, 2003

For: A DEVICE FOR TAKING CONTROL OF RESOURCES IN A COMMUNICATION NETWORK
IN ORDER TO INSERT TRAFFIC

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated November 27, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1-8, 10-12, 14, and 16 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Torikka et al. (U.S. Patent No. 6,937,577, hereafter "Torikka"). Claims 9, 13, 15, and 17-21 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Torikka in view of Karabinis (U.S. Patent No. 6,856,787). Applicant respectfully traverses the prior art rejections.

In the Amendment filed on September 5, 2007, Applicant submitted that there is no teaching or suggestion in Torikka of a data management device which includes "control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station" as recited in independent claim 1. Applicant

further submitted that it was unclear from the rejection what the Examiner considered to be the claimed “data management device.”

Further, Applicant submitted that column 9, lines 32-54 of Torikka, which the Examiner cites as allegedly disclosing this feature of the claim, merely discloses an operation for changing the functionality of system resources in a telecommunications network, wherein a control unit determines that the telecommunication system requires a different allocation of resources, and reconfigures several Asynchronous transfer mode Multiplication Boards (AMBs), so that the necessary changes are performed. Applicant submitted that nothing in this cited portion (or any other portion) of Torikka teaches or suggests a data management device which includes control means configured to be coupled to a traffic source, and which takes local control, on command, of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between the traffic source and the base station, as required by independent claim 1.

In response, the Examiner acknowledges that Torikka does not use the same terms as the claimed invention.² However, the Examiner asserts:

Nonetheless, Torikka discloses Radio Network Control (RNC) also known as Base Station Controller (BSC), which includes control unit for determining the system requirement for the allocation of resources due to a change in the functionality of the system resources (see e.g. fig. 1 and col. 9 lines 32-54).³

Applicant continues to find the Examiner’s position unclear. FIG. 9 and column 9, lines 32-54 of Torikka discloses that if a need for a change in the functionality of a telecommunications system arises, a system control unit determines that the telecommunication system requires a different allocation of

² Page 9 of the Office Action.

³ Page 10 of the Office Action.

resources than before. The functionality of an application processor and Asynchronous transfer mode Multiplication Boards is reconfigured such that necessary changes are performed.

The relevance of this cited portion of Torikka to the claimed invention remains unclear to Applicant. Nowhere does this cited portion of Torikka teach or suggest a data management device which takes control, on command, of at least a portion of the resources of a base station instead of a terrestrial node, to enable transfer of data between a traffic source and the base station, as required by the claim.

The Examiner appears to take the position that the claimed “data management device” allegedly reads on the Radio Network Control (RNC) of Torikka. However, the claimed invention clearly discloses that the Data Management Device (D) is separate from the RNC (FIG. 2) and can be substituted for the RNC (at least at page 12, lines 13-16). Accordingly, Applicant respectfully submits that the Examiner’s characterization that the claimed “data management device” reads on the RNC of Torikka is clearly erroneous.

The Examiner further asserts:

In response to applicant’s argument that “control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.⁴

Applicant respectfully submits that the structural difference between the claimed invention and the prior art is quite clear. There is no teaching or suggestion in the cited references of a data management device comprising control means configured to be coupled to a traffic source and to an

⁴ Page 10 of the Office Action.

interface. Further, and contrary to the Examiner's assertion, the prior art (Torikka) is not capable of performing an intended use of the claimed invention, since there is no teaching or suggestion in Torikka of any structure which is configured to take local control, on command, of a portion of resources in a base station, instead of a terrestrial node, to enable transfer of data between a traffic source and the base station.

The Examiner further asserts:

Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus Applicant intends that a broader interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections.⁵

Applicant respectfully submits that the Examiner's position is severely flawed for at least the following reasons.

First, it is well established that Applicants are entitled to draft claims as broadly as supported by the specification. Second, there is simply no requirement that Applicant has to amend the claims in order to narrow the claim language or to construe a narrower meaning or interpretation of the limitations. Applicants may choose to amend the claim language to distinguish over the prior art if the claimed invention reads on the prior art. However, in this instance, Applicant respectfully submits that the claimed invention does not read on the cited art. Accordingly, Applicant does not have to amend the claimed subject matter. Third, contrary to the Examiner's assertion, Applicant does not have to argue a narrower interpretation of the claims or amend the claims. Fourth, although it may be true that during examination the claims may be broadly interpreted in light of the specification, Applicant notes that the standard for claim interpretation is not the broadest possible meaning of the claim terms, but rather the broadest *reasonable* interpretation consistent with the specification. See MPEP 2111. Applicant submits

⁵ Page 10 of the Office Action.

that the Examiner's interpretation of the claim language is wholly unreasonable since the claimed data management device certainly does not read on the teachings of Torikka.

The Examiner further asserts:

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims.⁶

The Examiner's assertion that Applicant intends that a broad interpretation be given to the claims is clearly erroneous. Applicant expects that each limitation of the claim would be considered and interpreted in light of the specification.

Further, Applicant finds the Examiner's assertion that Applicant has failed to supply arguments commensurate in scope with the claims, unclear. At least on pages 9-13 of the Amendment filed on September 5, 2007, Applicant clearly set forth features of the claimed invention that were not disclosed by the cited references.

Accordingly, Applicant respectfully submits that claim 1 should be allowable because the cited references do not teach or suggest all of the features of the claim. Claims 2-21 should also be allowable at least by virtue of their dependency on independent claim 1.

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Date: April 28, 2008

⁶ Page 11 of the Office Action.